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The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 19

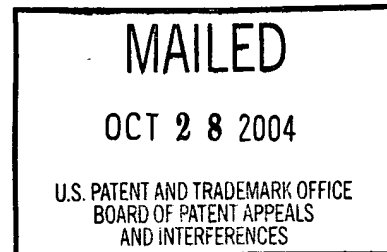
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESTER F. LUDWIG, J. CHRIS LAUWERS, KEITH A. LANTZ,
GERALD J. BURNETT, and EMMETT R. BURNS

Appeal No. 2004-0485
Application No. 09/702,737

ON BRIEF



Before THOMAS, DIXON, and BARRY, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-41,
which are all of the claims pending in this application.

We AFFIRM.

Appellants' invention relates to a participant display and selection in video conference calls. An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below.

21. A teleconferencing system for conducting a teleconference among a plurality of participants comprising:

- (a) a plurality of video display devices each having associated
 - (i) participant video capture capabilities, and
 - (ii) participant audio
 - (1) capture and
 - (2) reproduction capabilities; and
 - (b) at least one communication path
 - (i) along which signals
 - (1) representing participant audio and video
 - (ii) can be transmitted, wherein the system is configured to
- (a) display
- (i) a first and a second directory each including potential video-enabled participants in which
 - (1) the first directory is viewable by all potential video-enabled participants, and
 - (2) the second directory is a subset of the first directory and viewable by a single participant,

- (ii) on at least one video display device; and
- (b) to initiate collaboration
 - (i) upon a selecting participant establishing communication
 - (1) with a selected participant
 - (2) to define the teleconference.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Baumgartner et al. (Baumgartner) 5,195,086 Mar. 16, 1993

Marshak, R. T. "BeyondMail for Windows: epitomizing the mail-enabled application," Patricia Seybold's Office Computing Report, Vol. 15, No. 9, Sep. 1992.

Rangan et al. (Rangan), "Software Architecture for Integration of Video Services in the Etherphone System," IEEE Journal on Selected Areas in Communications, Vol. 9, No. 9, pp. 1395-1404, December 1991.

Claims 21-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baumgartner in view of Marshak and Rangan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed May 20, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed Mar. 4, 2003) and reply brief (Paper No. 15, filed Jul. 23, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants elected to group all of the claims as standing or falling together. (Brief at page 3.) Therefore, we may select either independent claims 21 or 30. Since we find a similar scope in both claims, we select independent claim 21 and will address appellants' arguments thereto.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant

teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not

'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 21.

From our review of the examiner's rejection and the prior art applied against the claims, we find that the combined teachings of the prior art references would have fairly suggested the invention recited in independent claims 21 and 30. Therefore, we will sustain the rejection of independent claims 21 and 30 and their respective dependent claims.

We have considered appellants' arguments and do not find them persuasive. We address appellants' arguments in the same order as found in the brief and reply brief. Appellants argue that several of the elements of the claims are missing from Baumgartner, Marshak, and Rangan and there is no suggestion or motivation to modify Baumgartner or Marshak or Rangan or to combine their teachings to obtain the claimed

invention. (Brief at page 4.) We disagree with appellants and find that appellants' argument is based upon the individual teachings rather than the combined teachings of the three references.

Appellants argue that the prior art generally lacks a disclosure or suggestion of multiple directories in a video conferencing environment. (Brief at page 4.) We disagree with appellants and find that Marshak suggests multiple directories which may be used in any addressed communications as taught by Baumgartner and Rangan. Appellants argue that the e-mail area and the video area are sufficiently remote from each other so that the ordinarily skilled artisan armed with the knowledge of multiple directories in an e-mail context would not have been led to apply that knowledge to the videoconferencing art. (Brief at page 4.) We disagree with appellants and find that appellants have not presented evidence to support this position.

Appellants argue that Baumgartner does not specifically disclose usage of video or video capture capabilities. (Brief at page 4.) We disagree with appellants and the examiner's admission and find that Baumgartner suggests the use of his system with video capabilities in the discussion of the problem in column 1, lines 41-44, line 67- column 2, line 1 and column 2, lines 45-46. From our review of the language of independent claim 21, we find no specific details of the workings of the video processing. Therefore, this argument is not persuasive.

Appellants argue that Baumgartner does not disclose the first or second directory in which the second directory is a subset of the first directory. Appellants argue that Baumgartner does not teach or suggest a second directory at all. (Brief at page 4.) While we agree that Baumgartner does not disclose a second directory as disclosed by appellants, we find that Baumgartner does in fact teach multiple layers of directories. Baumgartner teaches a first directory in Figure 18, then Baumgartner discloses the use of a directory for the room as shown in Figures 19, 23(a), 23(b), 24(a) and 24(b) where the conferences can be split or merged. Therefore, we find the display of the participants in a room is a subset of the overall directory in Figure 18 and that this display of a room is a directory from which the conference can be further split into smaller conferences. Therefore, the fact that each conference can be split makes each layer a further directory from which to split the conference or from which to merge up.

Appellants argue that Marshak and the teachings of e-mail have nothing to do with videoconferencing or with video-enabled participants. (Brief at page 5.) We disagree with appellants and find that similar problems are encountered in the routing and determining of connections of email enabled participants and the solutions to ease user interfacing. Appellants therefore conclude that Marshak does not teach or suggest "any directory including video-enabled participants." While we must agree with appellants, this is due to the fact that Marshak is an e-mail system; therefore, it would not generally have video-enabled participants, but for the transmission of static video

clips such as MPEG files. Yet, Marshak clearly teaches the use of a public and private address books to ease the user's addressing and routing of mail to desired recipients. (Marshak at page 4.) Appellants argue that Marshak is silent whether the second directory can or should be a subset of the first directory and therefore does not teach or suggest the desirability of such a feature. We agree that Marshak does not teach a requirement that the second directory be required to be only a subset of the first directory, but we find it abundantly clear that the second directory may at times be a subset of the first directory and that it is the ease of addressing and formation of the second directory which is the motivation and not to fact that one is a subset of the other that is the driving force in the second directory. We find that most users setting up the second/private directory would use the public address book initially in establishing the second/private directory so that initially, the second/private directory would meet this limitation of independent claims 21 and 30. Therefore, this argument is not persuasive.

Appellants argue that in the system of Rangan, a caller must embark on a complex multi-step procedure to initiate a video conference. Appellants argue that Rangan teaches no directories and hardly allows for rapid teleconferencing connection set-up. (See brief at page 5.) While we agree with appellants, we find no apparatus or method steps in the language of independent claims 21 and 30 which are specifically directed to rapid teleconferencing connection set-up. Therefore, this argument is not persuasive.

With respect to the teachings of Rangan, we note that Rangan teaches that the general video server must support visual conferences, support video editing and mailing services. (Rangan at page 1395, column 2, first paragraph.) Here, we find that the teaching of “mailing services” buttresses the combination of video conferencing technology with email technology as taught by Baumgartner and Marshak. Additionally, Rangan teaches the use of a WINDOWS based GUI wherein we find similarities to teachings of Marshak.

Appellants argue that the examiner has not cited a reference that teaches or suggests directories of video-enabled participants. (See brief at page 6.) We disagree with appellants and find that the combination of the three teachings would have suggested the use of directories of video-enabled participants. Therefore, this argument is not persuasive.

Appellants argue that the use of e-mail directories does not teach or suggest applicability of plural directories in a real-time videoconferencing context. (See brief at page 6.) We disagree with appellants; and we find the methodology to address and route e-mail communications readily applicable to video communications. Furthermore, we find no limitation in the language of independent claims 21 and 30 which persuade us that it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the three teachings and appellants have provided no evidence to the contrary. Appellants contrast the fast moving business activities with users able

to select participants in real time easily and quickly hiding the complex details of multichannel multimedia connection set up with the text exchange of Marshak. (See brief at pages 6-7.) Here, we do not find appellant's argument commensurate in scope with the claim language, and we find no language of independent claims 21 and 30 which persuade us that it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the three teachings and appellants have provided no evidence to the contrary. Therefore, this argument is not persuasive.

Appellants argue that the prior art does not provide a second directory to facilitate immediate communication. As discussed above, we do not find this argument commensurate in scope with appellants' claimed invention. Therefore, this argument is not persuasive. Appellants conclude that even if one skilled in the art were to attempt to combine the teachings of Baumgartner, Marshak and Rangan, the resulting combination would not result in the claimed invention with first and second directory each including potential video-enabled participants. (See brief at page 7.) We disagree with appellants as discussed above.

Appellants argue that the claimed invention requires the second directory to be a subset of the first directory and that Marshak does not require one directory to be a subset of the other. (See brief at page 8.) While we agree with appellants that Marshak does not require the private directory to be a subset of the public directory, we find that it would have been obvious to one of ordinary skill in the art at the time of the

invention that certain individuals would set up their directories in this manner initially, but that they private directory may extend to others outside the public directory. Here, we also note that there are additionally personal distribution lists which were known at the time of the invention as a further level of directory which would be only viewable to its owner and that these may also be a subset of the private and/or public directories. Therefore, this argument is not persuasive.

Appellants argue that the second directory is like the concept of "quick dial" or "hot keys" which are populated by a drag and drop function. (See brief at page 8.) Again, we do not find this argument commensurate in scope with appellants' claimed invention and not persuasive.

Appellants argue that Marshak does not teach or suggest the relationship between the two directories and speculates that "[r]ather than the subset relationship, the private directory could be totally different, or partly different from the public directory." (See brief at page 8.) We agree with appellants, but also add that the private directory could be a subset of the public directory. Therefore, this argument is not persuasive. Appellants argue that an e-mail system actually would tend to preclude the subset relationship since users want to communicate with e-mail users outside the network. (See brief at page 8.) Here again we find that appellants speculate as to how a user may use both the public and private directories and do not find this argument persuasive as discussed above. Contrary to appellants' argument that Marshak is

silent as to the goals of the private directory, we find that the storage of addresses of anyone with e-mail accessibility and use of the stored addresses would have been an improvement in the efficiency over the input of each separate e-mail address by typing out the addresses.

Appellants argue in the reply brief that same argument with respect to the second directory being a subset of the first directory. (See reply brief at page 2.) We disagree with appellants as discussed above. Appellants argue that the modification of Marshak would render the system of Marshak unsatisfactory for its intended purpose. (See reply brief at page 2.) Appellant speculates about what e-mail users want to do outside their network/e-mail system. We find this to be mere speculation. Further, we could speculate that the users of the present invention would similarly like to communicate with others outside its global directory and then a new or expanded first or global directory would have to be formed. Therefore, we do not find appellants' speculation to be a persuasive argument.

Appellants argue that the participants have associated video capture capability. (See reply brief at pages 3-4.) We do not find this argument persuasive as discussed above. Furthermore, we find it analogous to the e-mail addresses whereas all to those addresses in both the public and private directories have the capabilities for the communication system to which they are connected. In an e-mail system, it would be the e-mail addressing and routing information stored and it would have been obvious to

one of ordinary skill in the art at the time of the invention that with a video based communication the stored participants would have their addresses stored.

Appellants argue that the examiner is incorrect in the position that only one entry need be in common to be a subset. (See reply brief at page 5.) We agree with appellants' definition of a subset, but disagree with appellants' interpretation and speculation about the directories in Marshak as discussed above. Appellants again argue the concept of "quick dial." We do not find this argument commensurate in scope with appellants' claims. Therefore, this argument is not persuasive. Since appellants have not shown error in the examiner's *prima facie* case of obviousness or provided a convincing line of reasoning as to why it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the three references, we will sustain the rejection of independent claims 21 and 30 and their respective dependent claims.

Appellants argue the details of dependent claim 26 in the reply brief at page 6, but had previously elected to group all the claims together at page 3 of the brief. Claim 26 which depends from claim 21 has not been separately argued by appellants as required in 37 CFR § 1.192(c)(7) and (8)(iv) in the brief. Accordingly, we have determined that these claims must be treated as falling with their respective independent claim and argument thereto has been waived since appellants have not

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shown good cause why it was not earlier presented. **See In re Nielson**, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

CONCLUSION

To summarize, the decision of the examiner to reject claims 21-41 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

JOSEPH L. DIXON /
Administrative Patent Judge

~~LANCE LEONARD BARRY~~
Administrative Patent Judge

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